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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,289	11/20/2001	Jason Norman Morrow	30879.238175	9536

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EXAMINER

HARRIS, ANTON B

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/989,289	MORROW ET AL.	
	Examiner	Art Unit	
	Anton B. Harris	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35, 42-53, 57-61, 68-79, 83-87, 94-105 and 109-127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35, 42-53, 57-61, 68-79, 83-87, 94-105 and 109-127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 35, 45, 49, 61, 70, 71, 87, 96, 97, 113, 114, 115, 119, 123, and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock (U.S. Patent No. 3,367,370 cited by Applicant) in view of Pelzer (U.S. Patent No. 5,212,349 cited by Applicant) and Bergemann (DE 2,248,441).

Regarding claim 35, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous wire 20 coincident with the channel (figure 3 between

Art Unit: 2831

reference #'s 18) in the elongate polymeric tube 10 and having sufficient strength to tear through the conduit, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and directly under said channel, and a continuous high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and directly under said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Furthermore, claim 35 recites the limitation of "said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment." It has been held that the

Art Unit: 2831

recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

Regarding claim 45, Sherlock (col. 2, lines 41-46) discloses a wire coated 20 with a coating 24 composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

Regarding claim 49, Sherlock (col. 2, lines 41-46) discloses an elongate tube 10 having a predetermined wall thickness.

Regarding claim 61, Sherlock (col. 2, lines 41-46) discloses a toneable conduit, comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous wire 20 coincident with the channel (figure 3 between reference #'s 18) in the elongate polymeric tube 10 and having sufficient strength to tear through the conduit, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, integral with the elongate polymeric tube, and located radially inward from said channel, and a continuous high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A, and located radially inward from said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from said channel in order to provide strength to the conduit in view of the teachings of Bergemann

Furthermore, claim 61 recites that the high elongation wire is capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 70, the wire of Sherlock inherently has size. It would have been an obvious matter of design choice to modify the invention of Sherlock by providing a wire with a diameter of from about 0.32 mm to about 2.59 mm, since such a modification would have

Art Unit: 2831

involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 71, Sherlock (col. 2, lines 41-46) discloses that a wire 20 is coated with a coating 24 composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

Regarding claim 87, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous said wire 20 coincident with the channel (figure 3 between reference #'s 18) in the elongate polymeric tube 10 and having sufficient strength to tear through the conduit, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel, and a wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.

Pelzer (col. 12, lines 3-20 and figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion and make a permanent electrical contact in view of the teachings of Pelzer.

Bergemann (figure 1) shows a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and on the same radius as said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel in order to provide strength to the conduit in view of the teachings of Bergemann

Furthermore, claim 87 recites that the wire is “capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 96, the wire of Sherlock inherently has size. It would have been an obvious matter of design choice to modify the invention of Sherlock by providing a wire with a diameter of from about 0.32 mm to about 2.59 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 97, Sherlock (col. 2, lines 41-46) discloses a wire 20 coated with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

Art Unit: 2831

Regarding claim 113, the teachings of Bergemann further include that a stabilizing rib (figure 1) is integral with the elongate polymeric tube A.

Regarding claim 115, the teachings of Bergemann further include that a stabilizing rib (figure 1) is integral with the elongate polymeric tube A.

Regarding claim 114, the teachings of Bergemann further include that a stabilizing rib (figure 1) is integral with the elongate polymeric tube A.

Regarding claim 119, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and directly under said channel, and a continuous wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Art Unit: 2831

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and directly under said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Furthermore, claim 119 recites the limitation of “said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 123, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and supporting said channel, and a continuous wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.

Art Unit: 2831

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and supporting said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Furthermore, claim 123 recites the limitation of “said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 127, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the

Art Unit: 2831

wire from adhering to the polymer melt used to form the polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and on the same radius as said channel, and a continuous wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and on the same radius as said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Furthermore, claim 127 recites the limitation of "said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment." It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but

Art Unit: 2831

only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

3. Claims 42-44, 116, 117, 120, 121, 124, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock in view of Pelzer and Bergemann, as applied to claim 35 above and further in view of Craton.

Regarding claims 42 and 43, Sherlock modified as taught by Pelzer, Bergemann, discloses the invention substantially as claimed, but lacks a coating of a copper-clad steel wire.

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Regarding claim 44, the wire of Sherlock inherently has size. It would have been an obvious matter of design choice to modify the invention of Sherlock by providing a wire with a diameter of from about 0.32 mm to about 2.59 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 116, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and directly under said channel.

Art Unit: 2831

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and directly under said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Furthermore, claim 116 recites the limitation of “said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

Art Unit: 2831

Regarding claims 117, 121, and 125, Sherlock (col. 2, lines 41-46) discloses a wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

Regarding claim 120, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and supporting said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Art Unit: 2831

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Furthermore, claim 120 recites the limitation of “said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment.” It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 124, Sherlock (col. 2, lines 41-46) discloses a toneable conduit comprising: an elongate polymeric tube 10 having, a wall with an interior surface, an exterior surface, a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, but lacks a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel.

Pelzer (figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube in order to protect the wires from corrosion in view of the teachings of Pelzer.

Art Unit: 2831

Bergemann (figure 1) teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and on the same radius as said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann.

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Furthermore, claim 124 recites the limitation of "said wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment." It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

4. Claims 46-48 and 98-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock in view of Pelzer and Bergemann, as applied to claim 45 above and further in view of Tzeng et al.

Regarding claim 46, Sherlock modified as taught by Pelzer, Bergemann, discloses the invention substantially as claimed, but lacks a wire coated with a coating composition formed of

Art Unit: 2831

a polymeric material selected from the group consisting of fluoropolymers, polyamides, polyesters, polycarbonates, polypropylene, polyurethanes, polyacetals, polyacrylics, epoxies and silicone polymers

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polyesters.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a wire coated with polyesters in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Regarding claim 47, Tzeng et al. (col. 6, lines 11-14) teaches a coating composition formed of a polymeric material that has a melting temperature of at least about 500 degrees Fahrenheit.

Regarding claim 48, Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

Regarding claim 98, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks a coating composition formed of a polymeric material selected from the group consisting of fluoropolymers, polyamides, polyesters, polycarbonates, polypropylene, polyurethanes, polyacetals, polyacrylics, epoxies and silicone polymers.

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polyesters.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a wire coated with

Art Unit: 2831

polyesters in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Regarding claim 99, Tzeng et al. (col. 6, lines 11-14) teaches a coating composition formed of a polymeric material that has a melting temperature of at least about 500 degrees Fahrenheit.

Regarding claim 100, Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

Regarding claim 101, Sherlock (col. 2, lines 41-46) discloses an elongate polymeric tube 10 having a predetermined wall thickness.

5. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 49 above and further in view of Levingston et al. (U.S. Patent No. 6,105,649).

Regarding claim 50, Sherlock modified as taught by Pelzer, and Bergemann discloses the invention substantially as claimed, but lacks a smooth exterior surface of the tube.

Levingston et al. (col. 5, lines 50-54) teaches a smooth exterior surface of the tube 16.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a smooth exterior surface of the tube in order to enhance strength and external appearance in view of the teachings of Levingston et al.

6. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 35 above and further in view of Karl.

Art Unit: 2831

Regarding claim 51, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks a tube formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

Karl (col. 1, line 55) teaches a tube 12 formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Pelzer and Bergemann by providing a tube formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride in order to offer resistance to chemical attack in view of the teachings of Karl.

7. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer, Bergemann, and Karl as applied to claim 51 above and further in view of Bird.

Regarding claim 52, Sherlock modified as taught by Pelzer, Bergemann and Karl discloses the invention substantially as claimed, but lacks a tube formed of a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

Art Unit: 2831

8. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 35 above and further in view of Nakamura et al. (JP 05106779A cited by Applicant).

Regarding claim 53, Sherlock modified as taught by Pelzer, Bergemann, and Karl discloses the invention substantially as claimed, but lacks at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube.

Nakamura et al. (figure 1) shows at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube in order to strengthen the tube in view of the teachings of Nakamura et al.

9. Claims 57 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent No. 4,109,941) in view of Sherlock, Bergemann, and Pelzer.

Regarding claim 57, Wood et al. (abstract) discloses a method of coupling a first toneable conduit 1 with a second toneable conduit 3, comprising the steps of providing a first toneable conduit 1 comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness, and mechanically connecting the first conduit and the second conduit, but lacks a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube, and located radially inward from and directly under said channel; and a continuous, high elongation wire coincident with the channel in the

Art Unit: 2831

elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube; providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from said channel; and a continuous, high elongation wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube, tearing the high elongation wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the high elongation wire of the second toneable conduit through the exterior surface of the second toneable conduit; and electrically connecting the high elongation wire from the first toneable conduit and the high elongation wire from the second toneable conduit.

Sherlock (col. 2, lines 41-46) teaches a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous said high elongation wire 20 coincident with the channel (figure 3 between reference #'s 18) in the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a channel extending longitudinally of the wall of the elongate polymeric tube, a continuous said high elongation wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating,

Art Unit: 2831

composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube in order to print as desired in view of the teachings of Sherlock.

Pelzer (col. 12, lines 3-20 and figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12 and teaches tearing the high elongation wire 14 of the first toneable conduit 12 through the exterior surface of the first toneable conduit 12, tearing the high elongation wire 14 of the second toneable conduit 12 through the exterior surface of the second toneable 12 conduit, and electrically connecting the high elongation wire 14 from the first. toneable conduit 12 and the high elongation wire 14 from the second toneable conduit 12 (col. 12, lines 24-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube and including the step of a tearing the high elongation wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the high elongation wire of the second toneable conduit through the exterior surface of the second toneable conduit, and electrically connecting the high elongation wire from the first. toneable conduit and the high elongation wire from the second toneable conduit in order to protect the wires from corrosion and make a permanent electrical contact in view of the teachings of Pelzer.

Bergemann (figure 1) shows a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A, integral with the elongate polymeric tube, and located radially inward from and directly under said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located

Art Unit: 2831

radially inward from and directly under said channel in order to provide strength to the conduit in view of the teachings of Bergemann

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from said channel; and a continuous, high elongation wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering, to the polymer melt used to form the polymeric tube, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 83, Wood et al. (abstract) discloses a method of coupling a first toneable conduit 1 with a second toneable conduit 3, comprising the steps of providing a first toneable conduit 1 comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness, and mechanically connecting the first conduit and the second conduit, but lacks a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering

Art Unit: 2831

to the polymer melt used to form the polymeric tube; providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube, tearing the wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the wire of the second toneable conduit through the exterior surface of the second toneable conduit; and electrically connecting the wire from the first toneable conduit and the wire from the second toneable conduit.

Sherlock (col. 2, lines 41-46) teaches a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous said wire 20 coincident with the channel (figure 3 between reference #'s 18) in the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a channel extending longitudinally of the wall of the elongate polymeric tube, a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube in order to print as desired in view of the teachings of Sherlock.

Pelzer (col. 12, lines 3-20 and figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12 and teaches tearing the wire 14 of the first toneable conduit 12 through the exterior surface of the first toneable conduit 12, tearing the wire 14 of the second toneable conduit 12 through the exterior surface of the second toneable 12 conduit, and electrically connecting the wire 14 from the first toneable conduit 12 and the wire 14 from the second toneable conduit 12 (col. 12, lines 24-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube and including the step of a tearing the wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the wire of the second toneable conduit through the exterior surface of the second toneable conduit, and electrically connecting the wire from the first toneable conduit and the wire from the second toneable conduit in order to protect the wires from corrosion and make a permanent electrical contact in view of the teachings of Pelzer.

Bergemann (figure 1) shows a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A, and located radially inward from and supporting said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel in order to provide strength to the conduit in view of the teachings of Bergemann

Art Unit: 2831

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and supporting said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering, to the polymer melt used to form the polymeric tube, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

10. Claims 58 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 57, and further in view of Craton.

Regarding claim 58, Wood et al. as modified by Sherlock, Bergemann, Pelzer, and the advertisement by Pyramid Industries, Inc regarding the Toneable Duct product discloses the invention substantially as claimed, but lacks a copper-clad steel wire.

Craton.(col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Wood et al. as modified by Sherlock, Bergemann, and Pelzer by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Art Unit: 2831

Regarding claim 84, Wood et al. as modified by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a copper-clad steel wire.

Craton.(col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Wood et al. as modified by Sherlock, Bergemann, and Pelzer by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

11. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 57 and further in view of Tzeng et al.

Regarding claim 59, Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a coating of polytetrafluoroethylene.

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Sherlock, Bergemann, and Pelzer by providing a wire coated with polytetrafluoroethylene in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit with a wire coated with polytetrafluoroethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Art Unit: 2831

12. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 57 and further in view of Bird.

Regarding claim 60, Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Sherlock, Bergemann, and Pelzer by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. modified by Sherlock, Bergemann, and Pelzer by providing a second toneable conduit with a tube formed of a high-density polyethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

13. Claims 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 61 above, and further in view of Craton (U.S. Patent No. 6,139,957).

Regarding claim 68, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks that wire is selected from the group consisting of copper-clad steel wire, copper-clad aluminum wire, copper wire, and tin copper wire.

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

Art Unit: 2831

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Regarding claim 69, Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

14. Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 61 above, and further in view of Tzeng et al. (U.S. Patent No. 6,005,191).

Regarding claim 72, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks a coating composition formed of a polymeric material selected from the group consisting of fluoropolymers, polyamides, polyesters, polycarbonates, polypropylene, polyurethanes, polyacetals, polyacrylics, epoxies and silicone polymers.

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polyesters.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a wire coated with polyesters in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Regarding claim 73, Tzeng et al. (col. 6, lines 11-14) teaches a coating composition formed of a polymeric material that has a melting temperature of at least about 500 degrees Fahrenheit.

Regarding claim 74, Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

Art Unit: 2831

Regarding claim 75, Sherlock (col. 2, lines 41-46) discloses an elongate polymeric tube 10 having a predetermined wall thickness.

15. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann, as applied to claim 75 above and further in view of Levingston et al. (U.S. Patent No. 6,105,649).

Regarding claim 76, Sherlock modified as taught by Pelzer, and Bergemann discloses the invention substantially as claimed, but lacks a smooth exterior surface of the tube.

Levingston et al. (col. 5, lines 50-54) teaches a smooth exterior surface of the tube 16.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a smooth exterior surface of the tube in order to enhance strength and external appearance in view of the teachings of Levingston et al.

16. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 61 above and further in view of Karl (U.S. Patent No. 6,135,159).

Regarding claim 77, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks a tube formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

Karl (col. 1, line 55) teaches a tube 12 formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of

Art Unit: 2831

a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride in order to offer resistance to chemical attack in view of the teachings of Karl.

17. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer, Bergemann, and Karl as applied to claim 77 above and further in view of Bird (U.S. Patent No. 6,131,265).

Regarding claim 78, Sherlock modified as taught by Pelzer, Bergemann, and Karl discloses the invention substantially as claimed, but lacks a tube formed of a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

18. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 61 above and further in view of Nakamura et al. (JP 05106779A cited by Applicant).

Regarding claim 79, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube.

Nakamura et al. (figure 1) shows at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube 1.

Art Unit: 2831

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube in order to strengthen the tube in view of the teachings of Nakamura et al.

19. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 83 and further in view of Tzeng et al.

Regarding claim 85, Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a coating of polytetrafluoroethylene.

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Wood et al. modified by Sherlock, Bergemann, and Pelzer by providing a wire coated with polytetrafluoroethylene in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit with a wire coated with polytetrafluoroethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *See Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

20. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 83 and further in view of Bird.

Art Unit: 2831

Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Sherlock, Bergemann, and Pelzer by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. modified by Sherlock, Bergemann, and Pelzer by providing a second toneable conduit with a tube formed of a high-density polyethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

21. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer, and Bergemann as applied to claim 87 above, and further in view of Craton (U.S. Patent No. 6,139,957).

Regarding claim 94, Sherlock modified as taught by Pelzer, and Bergemann discloses the invention substantially as claimed, but lacks that wire is selected from the group consisting of copper-clad steel wire, copper-clad aluminum wire, copper wire, and tin copper wire.

Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

Art Unit: 2831

Regarding claim 95, Craton (col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

22. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann, as applied to claim 101 above and further in view of Levingston et al. (U.S. Patent No. 6,105,649).

Regarding claim 102, Sherlock modified as taught by Pelzer, and Bergemann discloses the invention substantially as claimed, but lacks a smooth exterior surface of the tube.

Levingston et al. (col. 5, lines 50-54) teaches a smooth exterior surface of the tube 16.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a smooth exterior surface of the tube in order to enhance strength and external appearance in view of the teachings of Levingston et al.

23. Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 87 above and further in view of Karl (U.S. Patent No. 6,135,159).

Regarding claim 103, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks a tube formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

Karl (col. 1, line 55) teaches a tube 12 formed of a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of

Art Unit: 2831

a polymeric material selected from the group consisting of polyethylene and polyvinyl chloride in order to offer resistance to chemical attack in view of the teachings of Karl.

24. Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer, Bergemann, and Karl as applied to claim 103 above and further in view of Bird (U.S. Patent No. 6,131,265).

Regarding claim 104, Sherlock modified as taught by Pelzer, Bergemann, and Karl discloses the invention substantially as claimed, but lacks a tube formed of a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

25. Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer and Bergemann as applied to claim 87 above and further in view of Nakamura et al. (JP 05106779A cited by Applicant).

Regarding claim 105, Sherlock modified as taught by Pelzer and Bergemann discloses the invention substantially as claimed, but lacks at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube.

Nakamura et al. (figure 1) shows at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube 1.

Art Unit: 2831

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing at least one additional rib extending longitudinally along the interior surface of the elongate polymeric tube in order to strengthen the tube in view of the teachings of Nakamura et al.

26. Claim 109 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent No. 4,109,941) in view of Sherlock, Bergemann, and Pelzer.

Regarding claim 109, Wood et al. (abstract) discloses a method of coupling a first toneable conduit 1 with a second toneable conduit 3, comprising the steps of providing a first toneable conduit 1 comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness, and mechanically connecting the first conduit and the second conduit, but lacks a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube; providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering

Art Unit: 2831

to the polymer melt used to form the polymeric tube, tearing the wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the wire of the second toneable conduit through the exterior surface of the second toneable conduit; and electrically connecting the wire from the first toneable conduit and the wire from the second toneable conduit.

Sherlock (col. 2, lines 41-46) teaches a channel (figure 3 between reference #'s 18) extending longitudinally of the wall of the elongate polymeric tube 10, a continuous wire 20 coincident with the channel (figure 3 between reference #'s 18) in the elongate polymeric tube 10, said wire coated 20 with a coating 24, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube 10.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a channel extending longitudinally of the wall of the elongate polymeric tube, a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating, composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube in order to print as desired in view of the teachings of Sherlock.

Pelzer (col. 12, lines 3-20 and figure 10) teaches a channel 18 within the wall 16 of the polymeric tube 12 and teaches tearing the wire 14 of the first toneable conduit 12 through the exterior surface of the first toneable conduit 12, tearing the wire 14 of the second toneable conduit 12 through the exterior surface of the second toneable 12 conduit, and electrically connecting the wire 14 from the first toneable conduit 12 and the wire 14 from the second toneable conduit 12 (col. 12, lines 24-27).

Art Unit: 2831

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock by providing a channel within the wall of the polymeric tube and including the step of a tearing the wire of the first toneable conduit through the exterior surface of the first toneable conduit, tearing the wire of the second toneable conduit through the exterior surface of the second toneable conduit, and electrically connecting the wire from the first toneable conduit and the wire from the second toneable conduit in order to protect the wires from corrosion and make a permanent electrical contact in view of the teachings of Pelzer.

Bergemann (figure 1) shows a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube A and located radially inward from and on the same radius as said channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from and on the same radius as said channel in order to provide strength to the conduit in view of the teachings of Bergemann

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit comprising an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward

Art Unit: 2831

from said channel; and a continuous wire coincident with the channel in the elongate polymeric tube, said wire coated with a coating composition that prevents the wire from adhering, to the polymer melt used to form the polymeric tube, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

27. Claim 110 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 109, and further in view of Craton.

Regarding claim 110, Wood et al. as modified by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a copper-clad steel wire.

Craton.(col. 4, line 11) teaches a copper-clad steel wire 12 or 15.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Wood et al. as modified by Sherlock, Bergemann, and Pelzer by providing a copper-clad steel wire in order to be used as a metallic conductor in view of the teachings of Craton.

28. Claim 111 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 109 and further in view of Tzeng et al.

Regarding claim 111, Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a coating of polytetrafluoroethylene.

Tzeng et al. (col. 4, line 11) teaches a wire 14 coated with polytetrafluoroethylene.

Art Unit: 2831

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Sherlock, Bergemann, and Pelzer by providing a wire coated with polytetrafluoroethylene in order to be residually stressed into an expanded shape in view of the teachings of Tzeng et al.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. by providing a second toneable conduit with a wire coated with polytetrafluoroethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

29. Claim 112 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as modified by Sherlock, Bergemann, and Pelzer above in claim 57 and further in view of Bird.

Regarding claim 112, Wood et al. modified as taught by Sherlock, Bergemann, and Pelzer discloses the invention substantially as claimed, but lacks a high-density polyethylene.

Bird (col. 4, line 42) teaches a tube 12 formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Sherlock modified by Sherlock, Bergemann, and Pelzer by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Wood et al. modified by Sherlock, Bergemann, and Pelzer by providing a second toneable conduit with a tube formed of a high-

Art Unit: 2831

density polyethylene, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

30. Claims 118, 122, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherlock as modified by Pelzer, Bergemann, and Craton as applied to claims 116, 121, and 124 above, and further in view of Bird.

Regarding claims 116, 121, and 124, Sherlock modified as taught by Bergemann, Pelzer and Craton discloses the invention substantially as claimed, but lacks teaches a tube formed of a high-density polyethylene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified invention of Sherlock by providing a tube formed of a high density polyethylene in order to have the advantage of a flexible plastic material in view of the teachings of Bird.

Response to Arguments

31. Applicant's arguments filed 07 October 2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument that the combination of references does not disclose a stabilizing rib integral with the elongate polymeric tube, Examiner disagrees. The teaching of Bergemann (figure 1) clearly shows a stabilizing rib B extending longitudinally along the interior surface of the wall of the elongate polymeric tube, integral with the elongate polymeric tube.

Art Unit: 2831

Regarding Applicant's argument that the combination of references does not disclose a wire having significant strength to tear through the conduit, Examiner disagrees. Wires have inherent strength and possess significant strength to tear through conduits.

Regarding Applicant's argument that Craton does not teach the same use of the copper-clad steel wire, Examiner further explains. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.


Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anton B Harris whose telephone number is (571) 272-1976. The examiner can normally be reached on weekdays from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dean Reichard, can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

ABH

8/18/06


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